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Grant C. Paton

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EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3691

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | | |
|------------------------------|--------------------------------------|--|--|--|
| Office Action Summary | Application No. 09/826,678 | | Applicant(s) PATON, GRANT C. | |
| | Examiner Daniel Kesack | | Art Unit 3691 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 01 May 2008.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-6,8,10,21-25 and 27 is/are pending in the application.

 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-6,8,10,21-25 and 27 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. In view of the Appeal Brief filed on May 1, 2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Alexander Kalinowski/

Supervisory Patent Examiner, Art Unit 3691

Status of Claims

2. Claims 1-6, 8, 10, and 21-25, and 27 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-3, 8, 10, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson et al., U.S. Patent No. 6,574,603, in view of Hayashi et al., U.S. Patent No. 6,631,313.

Claims 1, 8, Dickson discloses an in-vehicle ordering system and method comprising:

locating the vehicle adjacent a transaction terminal (figure 1, #52, #14);

transferring computer data from the transaction terminal to an in-car data entry facility maintained within the vehicle, which programs generate a user interface in the entry facility (column 16 lines 1-11, and column 18 lines 15-17, 28-40)

entering user instructions into the in-car data entry facility and transmitting the user instructions locally to the terminal for execution by the terminal (column 18 lines 41-61).

Dickson fails to teach the data being transferred to the in-car data entry facility is a program.

Hayashi teaches a communication system for communication between in-vehicle terminals and a center, wherein a program is downloaded from a center to an in-vehicle terminal wirelessly (column 1 line 56 – column 2 line 6). As cited above, Dickson teaches transmitting the menu data to an in-vehicle controller from a transaction terminal. As admitted by Applicant in the Appeal Brief filed May 1, 2008, Dickson teaches "data which is fed to a pre-existing program in his IVC. That program determines what is displayed" (page 30). Examiner further notes that a program which, when run, determines what is displayed is equivalent to a program generating a display. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Dickson to include transmitting this program from the terminal to the in-car data entry facility, as discussed in Hayashi. As in Hayashi, it is

within the capabilities of one of ordinary skill in the art to wirelessly deploy an entire program to an in car computer with the predicted result of running whatever program is received as taught by Hayashi.

Claim 2, Dickson teaches a step of identifying the user (transmitting identifying indicia - column 18 lines 56-59, column 19 lines 15-35).

Claim 3, Dickson teaches transmitting data locally from the terminal to the vehicle, and displaying a part of the data on an in-car display located within the vehicle (column 16 lines 1-11, and column 18 lines 15-17, 28-40).

Claim 10, Dickson teaches memory storage means for recording data (column 18 lines 23-35).

Claim 27, In addition to the citations provided with respect to claim 1, Dickson describes the intelligent vehicle controller being used in a variety of environments, Including a fuel dispenser, as well as a different quick service restaurants. While Dickson does not teach the act of locating the vehicle adjacent a second terminal, and receiving a second program, these different environments will inherently have different interfaces because the transactions being preformed are completely different. Furthermore, common sense dictates that different restaurants have different menus and different prices. Prices at the same restaurant in the same location may change.

Even the same restaurant with the same menu may have different prices depending on location. All of these scenarios would result in a different interface being displayed to the user.

6. Claims 21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson et al., in view of DeVries, Jr. et al., U.S. Patent No. 6,547,133.

Claims 21, 23, 24, Dickson teaches maintaining a wireless communication device within a vehicle (figure 4B), positioning the vehicle near a terminal (figure #1, #52, #14), establishing wireless communication between the wireless device and the terminal (column 18 lines 41-51), identifying the user (transmitting identifying indicia - column 18 lines 56-59, column 19 lines 15-35), and completing a transaction upon verification (column 18 line 52 – column 19 line 35).

Dickson fails to teach the terminal being an ATM machine, and entering identification data into the wireless device which allows the ATM to verify the identity of the user.

DeVries Jr. discloses a remote transaction interface system within a vehicle in which a user locates the vehicle within a proximity of a terminal, which may be a drive-through food service, or a bank teller machine, and uses a card reader device within the vehicle to enter bank card information, and a PIN number which identifies the user, in order to complete a financial transaction (column 5 line 31 – column 6 line 37). It would

have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Dickson to include the ATM features of DeVries Jr. because both Dickson and DeVries Jr. are disclosed as being used to order food at a quick service restaurant, and Dickson includes the claimed features necessary to operate an ATM, including a keypad and a card reader. The inclusion of the ATM features into the system of Dickson would be desirable because the result would be an in car transaction device capable of performing more functions. Drive-up ATMs are old and well known in the art to be a popular transaction terminal used by drivers, and Dickson clearly intends the in-vehicle device to be diverse in its functions, because of the included support for many transactions which a driver commonly encounters.

Furthermore, the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

7. Claims 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson and DeVries, Jr., as applied above, and further in view of Hayashi.

Dickson and DeVries fail to teach transferring one or more computer programs from the terminal to the device. As cited above, Dickson teaches transferring data to be run on programs which are preexisting in the IVC.

Hayashi teaches a communication system for communication between in-vehicle terminals and a center, wherein a program is downloaded from a center to an in-vehicle terminal wirelessly (column 1 line 56 – column 2 line 6). The rationale for the combination of Hayashi and Dickson is provided above, regarding claim 1. Furthermore, while Dickson fails to teach the terminal being an ATM, it would be obvious to modify the reference in view of DeVries Jr. to include an ATM, as disclosed above, regarding claim 21.

Furthermore, while Dickson, DeVries Jr., and Hayashi fail to teach inserting the card and entering a PIN both in response to a prompt issued by the interface, Official Notice is taken that ATM machines have interfaces for interacting with users, and the interfaces issuing prompts for a user to enter a card and to enter a PIN is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Dickson, DeVries Jr., and Hayashi to include the prompting because ATMs are designed to be user-friendly, and providing instructions on how to operate the machine increases the usability.

8. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson, DeVries, Jr., and Hayashi et al., as applied to claims 21 and 25 above, and further in view of Ohki et al., U.S. Patent No. 5,952,639.

Dickson, DeVries, and Hayashi fail to teach uploading electronic valuable media to a memory storage device, and downloading electronic valuable media to a terminal from a memory storage device.

Ohki discloses a system and method for depositing and withdrawing electronic money between and ATM and an IC card (figure 8). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Dickson, DeVries, and Hayashi to include the electronic money transfer of Ohki because DeVries teaches interaction with an ATM, and Dickson teaches the device within the vehicle including a smart card reader (column 10 lines 20-31). Although Dickson fails to teach how the smart card reader is used, it is old and well known in the art that smart cards are commonly used to store electronic money, as a convenient method for completing transactions.

Response to Arguments

9. Applicant's arguments with respect to claims 1-6, 8, 10, 21-25, and 27, have been considered but are moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art
Unit 3691

Respectfully Submitted,

Daniel Kesack
July 18, 2008
/D. K./
Examiner, Art Unit 3691